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| 09/788,388 | 02/21/2001 | Sumiyo Okada | 1573.1002 | 5407 |

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EXAMINER

CHEN, CHONGSHAN

| ART UNIT | PAPER NUMBER |
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2162

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,388

Applicant(s)

OKADA ET AL.

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-36,38,39,41-73,75-78,80 and 81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-36,38,39,41-73,75-78,80 and 81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to Amendment filed on 10 June 2004. Claims 1, 2, 4-36, 38, 39, 41-73, 75-78, 80, and 81 are pending in this Office Action.

Response to Arguments

2. Applicant's arguments filed on 10 June 2004 have been fully considered but they are not persuasive.

3. As per applicant's arguments regarding the references do not teach a deleting unit to delete keyword having a degree of importance lower than a predetermined threshold value have been considered but are not persuasive. Norihiko discloses a real-time chat system that registers important keywords (Norihiko, [0010]-[0013]), which means the non-important keywords (the keywords have a degree of importance lower than a predetermined threshold value) is deleted or not registered. Furthermore, it is well known in the art that a deleting unit is able to delete unimportant keywords (please see Batchelder et al. US 5,691,708, col. 11, lines 18-22). By deleting the unimportant keywords, the user can easily know what is important keywords in the message.

4. As per applicant's arguments regarding "although the claims are not so restricted, the degree of importance may be determined in accordance with the presence or absence of a user's transmitted message responsive to a received message, with the response time delay from the reception, and with the user's current operation on the IRC client. In contrast, in JP HEI 10-69482 A (Nishimoto), the degree of importance is determined only in accordance with the frequency of a keyword" have been considered but are not persuasive. Nishimoto discloses the

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degree of importance may be determined based on the appearance frequencies and appearance intervals of the respective keywords (Nishimoto, page 11). The appearance intervals in a messenger inherently includes time intervals between messages and time intervals between user responses.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-36, 38, 39, 41-73, 75-78, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. ("Nishimoto", Japanese Patent, Document No. H10-69482).

As per claim 1, Norihiko teaches a message transmitting and receiving apparatus comprising:

a memory, storing keywords associated with said apparatus and degrees of importance of said keywords (Norihiko, [0010]);

a detector, detecting an occurrence of a transmitted or received message; an extractor, in response to the detection of an occurrence of a received message, extracting a keyword from said received message (Norihiko, [0018]-[0025]);

an indicator providing an indication of the occurrence of said extracted keyword within said received message in accordance with the determined degree of importance of said extracted keyword (Norihiro, [0005]-[0012]).

Norihiro discloses determining importance of a keyword ([0005]-[0025]), but Norihiro does not explicitly disclose determining dynamically a degree of importance of said extracted keyword and updating said keywords and said degrees of importance in said memory, wherein the degree of importance of the keywords changes in accordance with time. The examiner interprets the dynamic determining mean as a process in which the importance of a keyword may change based on various conditions during the determining process. Nishimoto teaches a method for determining the importance of a key and the importance of keyword changes during the process based on the appearance frequencies and appearance intervals (Nishimoto, page 11). Therefore, the importance determining mean of Nishimoto is dynamic. Furthermore, the dynamic determining mean of Nishimoto updates the degree of importance accordance with time. In Nishimoto's system, the keyword importance determining mechanism is used in a chat system and based on the appearance intervals of the respective keywords. There is a time difference between the appearance of words because words are spoken by a user one by one, which means the appearance intervals of the keywords means time intervals between the appearance. Clearly, the importance determining mechanism updates the importance based on the time of the appearance of the keyword. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the dynamic importance determining mean which updates the importance according to time in the system of Norihiro so

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that the chat system can track what topic the users are talking currently. This enables a chat participant to hold the flow of the talk easily.

Neither Norihiko nor Nishimoto explicitly discloses a deleting unit to delete a keyword having a degree of importance lower than a predetermined threshold value. However, Norihiko discloses a real-time chat system that registers important keywords (Norihiko, [0010]-[0013]), which means the non-important keywords (the keywords have a degree of importance lower than a predetermined threshold value) is deleted or not registered. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a deleting unit to delete unimportant keywords in the chat system of Norihiko. By deleting the unimportant keywords, the user can easily know what is important keywords in the message.

As per claim 2, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach providing at least one of visual and audio indications of an occurrence of said extracted keyword in a manner determined by a degree of importance of said extracted keyword (Norihiko, [0005]).

As per claim 4, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach storing a new keyword extracted from a received message in said memory together with a degree of importance of said new keyword (Norihiko, [0018]).

As per claim 5, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach said extractor extracts also a candidate keyword from a received message, and said apparatus further comprises a register, storing in said memory, a candidate keyword as a keyword, together with a degree of importance of the candidate keyword,

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when a user of the apparatus responds to received message data containing the candidate keyword within a predetermined range (Norihiro, [0019]).

As per claim 6, Norihiro and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of messages. However, Norihiro discloses said predetermined range is a predetermined number of lines (Norihiro, [0019]). In the real-time chat system of Norihiro, usually one line is one message. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of messages in order to extract keywords from previous messages.

As per claim 7, Norihiro and Nishimoto teach all the claimed subject matters as discussed in claim 5, and further teach said predetermined range is a predetermined number of lines (Norihiro, [0019]).

As per claim 8, Norihiro and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of words. However, Norihiro discloses said predetermined range is a predetermined number of lines (Norihiro, [0019]). The user would like to set the predetermined range as a predetermined number of words in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of words in order to define how many words the user wants to review.

As per claim 9, Norihiro and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined

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number of characters. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). The user would like to set the predetermined range as a predetermined number of characters in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of characters in order to define how many characters the user wants to review.

As per claim 10, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, and further teach said predetermined range is a predetermined time period (Nishimoto, page 11, In Nishimoto's system, the keyword importance determining mechanism is used in a chat system and based on the appearance intervals of the respective keywords. There is a time difference between the appearance of words because words are spoken by a user one by one, which means the appearance intervals of the keywords means time intervals between the appearance. Therefore, Nishimoto teaches determining importance using time period).

As per claim 11, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said message data within a predetermined range are messages received consecutively from a same client. However, the purpose of Norihiko's invention is for a chat participant to be able to hold the flow of the talk easily with another user. It is obvious the messages are received from a same client. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive messages from a same client in order to concentrate on the chat with the same user.

As per claim 12, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored

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in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword (Norihiko, [0018]-[0019]).

As per claim 13, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword within a predetermined range (Norihiko, [0018]-[0022]).

Claims 14-19 and 28-33 are rejected on grounds corresponding to the reasons given above for claims 6-11.

Claims 20-26 are rejected on grounds corresponding to the reasons given above for claims 1 and 10.

As per claim 27, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with the number of occurrences of the keyword in a predetermined range of received message data (Norihiko, [0018]-[0022]).

Claim 34 is rejected on grounds corresponding to the reasons given above for claims 1 and 10.

As per claim 35, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with an attribute of a received message containing the keyword (Norihiko, [0010]-[0015]).

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As per claim 36, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 35, and further teach the attribute of said received message is a network, a channel or a client (Norihiko, [0010]-[0015]).

Claims 38-39 and 41-48 are rejected on grounds corresponding to the reasons given above for claims 1-2 and 4-11.

Claims 49-55 are rejected on grounds corresponding to the reasons given above for claims 13-19.

Claim 56 is rejected on grounds corresponding to the reasons given above for claim 12.

Claims 57-73 are rejected on grounds corresponding to the reasons given above for claims 20-36.

Claim 75 is rejected on grounds corresponding to the reasons given above for claim 1.

Claim 76 is rejected on grounds corresponding to the reasons given above for claim 13.

Claim 77 is rejected on grounds corresponding to the reasons given above for claim 26.

Claim 78 is rejected on grounds corresponding to the reasons given above for claim 35.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Batchelder et al. (US 5,691,708) disclose a deleting unit to delete keywords having a degree of importance lower than a predetermined threshold value (col. 11, lines 18-22).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (703) 305-8319.

As of October 21, 2004, new number should be (571) 272-4031. The examiner can normally be reached on Monday-Friday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790.

As of October 21, 2004, new number should be (571) 272-4107.


The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 29, 2004


SHAHID ALAM
PRIMARY EXAMINER
